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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/727,290

12/03/2003

Peter M. Bonutti

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PAUL D. BIANCO

Fleit Gibbons Gutman Bongini & Bianco PL

21355 EAST DIXIE HIGHWAY

SUITE 115

MIAMI, FL 33180

EXAMINER

PHILOGENE, PEDRO

ART UNIT

PAPER NUMBER

3733

MAIL DATE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/727,290	<b>Applicant(s)</b> BONUTTI, PETER M.	
	<b>Examiner</b> Pedro Philogene	<b>Art Unit</b> 3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 August 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9,10,12,13,15-28 and 30-41 is/are allowed.
- 6) ☒ Claim(s) 1-8,11,14,29,42 and 43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8/20/08</u> .   | 6) <input type="checkbox"/> Other: _____                          |

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-7, 11, 42, 43 are rejected under 35 U.S.C. 102(e) as being anticipated by Engh et al. (6,482,209).

With respect to claims 1, 43, Engh et al disclose a prosthetic implant system for repairing a knee joint in a body of a patient, comprising a first member (136) including a first articulating member, the first member affixable to only one of a medial and lateral condyle of a femur portion of the knee joint; as best seen in FIGS.38-42, a second member (134) including an articulating surface, the second member affixable to a trochlear section of the femur portion; as best seen in FIGS.38-39; a third member (150) including a third articulating surface, the third member affixable to an end portion of a tibia portion of the knee joint opposite the first member, the first, second, and third members may be implanted irrespective of the implantation of any other of the first, second, and third members; and wherein the first, second and third members are implantable without a requirement for severing either cruciate ligament, as set forth in column 8, lines 47-49.

With respect to claims 2-7, 11,42, Engh et al disclose all the limitations; as set forth in column 8, lines 47-49, column 13, lines 51-67, column 14, lines 20-41.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8, 14, 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Engh et al. (6,482,209) in view of Hughes (6,589,248).

It is noted that Ebgh et al teach all the limitations, except for the first and third articulating surface that are magnetically charged; as claimed by applicant. However, in similar art, Hughes provides the evidences of the use of magnetically charged articular components to allow the components to move freely on one another.

Therefore, given the teaching of Hughes, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Engh et al to allow the components to move freely on one another.

***Response to Arguments***

Applicant's arguments filed 8/20/08 have been fully considered but they are not persuasive. First applicant's withdrawal of the Rule 131 Affidavit is noted. Furthermore, although applicant is arguing of that Engh et al only contemplates at least the replacement of both femoral condyles; and that there is no disclosure or suggestion of the articulating surface of only one condyle and a portion of the thochlear groove being

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replaced; however in the claims applicant is only claiming that “the first member affixable to only one of the a medial and lateral condyle of the femur portion”. As understood by the examiner and as best seen in FlgS38-39 of Engh et al, the first member (136 or 132) is affixable to only one medial and lateral condyle, not to both medial and lateral condyles. Therefore, the reference to Engh et al meets the claims, as claimed by applicant.

***Allowable Subject Matter***

Claims 9, 10, 12, 13, 15-28, 30-41 are allowed.

***Conclusion***

A shortened statutory period for reply to this action is set to expire THREE MONTHS from the mailing date of this action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pedro Philogene whose telephone number is (571) 272-4716. The examiner can normally be reached on Monday to Friday 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272 - 4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Pedro Philogene/  
Primary Examiner, Art Unit 3733  
December 2, 2008